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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,770	06/18/2007	Heike Gielen-Haertwig	BHC 041036	2475
35969 7590 06/21/2010 Barbara A. Shimei Director, Patents & Licensing Bayer HealthCare LLC - Pharmaceuticals 555 White Plains Road, Third Floor Tarrytown, NY 10591				
EXAMINER				
RAO, DEEPAK R				
ART UNIT		PAPER NUMBER		
1624				
MAIL DATE		DELIVERY MODE		
06/21/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/590,770

Applicant(s)

GIELEN-HAERTWIG ET AL.

Examiner

Deepak Rao

Art Unit

1624

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI.08)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to the amendment filed on March 16, 2010.

Claims 1-13 and 19 are pending in this application.

Withdrawn Rejections/Objections:

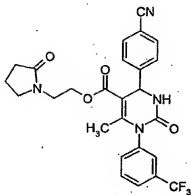
Applicant is notified that any outstanding rejection/objection that is not expressly maintained in this office action has been withdrawn or rendered moot in view of applicant's amendments and/or remarks.

The following rejections are maintained:

1. Claims 1-13 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Gielen et al., WO 2004/024700 (International filing date: August 28, 2003). The instant claims read on reference disclosed compounds, see the structural formula (I) in page 3 and the corresponding compounds of the examples. The reasons from the previous office action are incorporated here by reference.

Applicant's arguments have been fully considered but they were not deemed to be persuasive. Applicant argues that 'Gielen'700 reference does not disclose or even suggest the presently claimed definition of R^{4a} . This is not found to be persuasive because the reference teaches a generic group of compounds and further discloses compounds that fall within the instantly claimed genus of formula (I). See the structural formula (I) in page 3 and structural formula (IA) in page 16 of the reference and the corresponding species of the Examples. For

example, see the compound of Example 30 (page 67) of the reference (structure depicted below for convenience):



The structural formula (I) of the instant claims represents the above compound when:

R¹ is H;

R² is CN;

A is phenyl;

R⁶ is H;

Y¹-Y⁵ are CH;

R³ is H;

R⁷ is CF₃;

R⁵ is methyl; and

R⁴ is C₂alkoxycarbonyl substituted by a 5-membered heterocyclyl wherein the 5-membered heterocyclyl is pyrrolidinyl, which pyrrolidinyl is further substituted by oxo.

As can be seen from the above, the reference discloses a compound that falls within the instantly claimed genus. Further, the reference compounds are taught to be useful as pharmaceutical therapeutic agents for the treatment of chronic obstructive pulmonary diseases,

etc., see the abstract. Therefore, contrary to applicant's arguments, the Gielen'700 reference discloses a compound that falls in the instantly claimed genus and suggests the structural analogs thereof. Accordingly, the rejection is maintained.

2. Claims 1-13 and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over pending claims of each of copending Application No. 10/590,786 (now allowed).
3. Claims 1-13 and 19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 7,687,510 (issued from application S.No. 10/527,391).

The reasons from the previous office action are incorporated hereby reference. Applicant's argument that 'applicant will overcome this rejection or file a terminal disclaimer when the provisional rejection becomes an actual double patenting rejection' is acknowledged. The application S.No. 10/527,391 is currently U.S. Patent No. 7,687,510 (issued March 30, 2010).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**/Deepak Rao/
Primary Examiner
Art Unit 1624**

June 21, 2010